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EXAMINER

CAO, PHUONG THAO

ART UNIT	PAPER NUMBER
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2164

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/767,511	Applicant(s) KOPPEL ET AL.	
	Examiner Phuong-Thao Cao	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Exhibit A</u> . |

DETAILED ACTION

1. This action is in response to Amendment filed on 1/22/2007.
2. Claims 1-10 have been amended. Currently, claims 1-10 are pending.

Response to Amendment

3. The Affidavit or Declaration under 37 CFR 1.131 filed on 1/22/2007 under 37 CFR 1.131 has been entered in the application file but the information referred therein has not been considered as to the merits. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Millet et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The examiner acknowledges applicants' two attached exhibits, wherein Exhibit 1 is a manual entitled *ExtraView Administrator's Guide* and Exhibit 2 is a manual entitled *ExtraView Schema*. However, Applicants fail to specifically point out or map specific portions of the exhibits that correspond to specific limitations of the pending claims 1-10 in the applicants' submitted Exhibits. In 37 CFR 1.131(b) "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or

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conception of the invention prior to the reduction to practice or to the filing of the application.

Original exhibits of drawings or records, or photocopies thereof, must accompany and from of the affidavit or declaration or their absence satisfactorily explained. (See M.E.P. 715.08). For example in the independent, Claim 1 recites "forming a first user-defined data field structure, or first UDF" corresponds to which specific part of the Applicant's exhibits (Exhibit 1 or Exhibit 2); "a record identifier datafield" corresponds to which specific part of the Applicant's exhibits (Exhibit 1 or Exhibit 2); "a UDF identifier datafield" corresponds to which specific part of the Applicant's exhibits (Exhibit 1 or Exhibit 2); and so on. If the Applicants believe that the invention as claimed is described in the Applicants' exhibits as indicated in the Declaration under *37 C.F.R. § 1.131* pages 1-2, an indication as to where the cited claims language are taught in the portion of the Applicants' exhibits would not be so difficult to show. Therefore, Applicants are hereby required specifically pointing out or mapping each claim limitation into his/her submitted exhibits.

4. Amendment is objected to because of the following informalities: numerals representing specific line number of the page run together with texts of the claims; which makes it hard to read and identify the recited claims, for instance, on page 4, claim 3 becomes 53, "the name" becomes "the 10name", and so on. Corrections are required in the following amendment.

Specification

5. The amendment of the specification filed on 1/22/2007 has not been considered because it introduces new matter. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The Applicant has deleted a portion of the disclosure “Transmission media can also take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications” in order to overcome 101 rejection set forth in the last office action. Such deletion is not permitted. As a result, amendment to the specification is not entered. (see Exhibit A)

Claim Objections

6. Claims 6 and 8 are objected to because of the following informalities: claim 6: “the plurality of first datafields of each of the plurality of UDF’s” (line 11) should be changed to “the plurality of first datafields of the plurality of UDF’s” since the specification (see page 6) discloses that each UDF includes a first datafield, not a plurality of first datafields as claimed; claim 8: missing word “of” – the phrase “a plurality UDF’s” (line 5) should be “a plurality of UDF’s”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, the claimed features of "a controller", "the memory communicatively coupled with the controller", and "the database manager software program for directing the controller to merge the user-defined field with the record to associate the datum of the user-defined field with the record of the table" are not described in the specification to enable one having ordinary skill in the art to make and use the invention. The specification paragraph [0069] discloses that when the database manager queries the database with a specific question, the database manager will merge the UDF's associated with the records of the table in the process of answering the query. However, such abovementioned of the specification as well as the whole specification does not mention a controller which is coupled to a memory and directed by the database manager to merge the user-defined field with the record.

Based on the analysis provided above and substantial evidence or reasoning, the examiner provided that one having ordinary skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. The limitation as claimed in claim 10 "a controller", "the memory communicatively coupled with the controller", and "the

database manager software program for directing the controller to merge the user-defined field with the record to associate the datum of the user-defined field with the record of the table” are not supported by the as-filed disclosure, which is violated the written description

requirement. In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). Applicant should duly note that the first paragraph of 35 U.S.C. 112 requires that the “specification shall contain a written description of the invention”. Applicant should also note that the essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed; and to put the public in possession of what the applicant claims as the invention.” Furthermore, the written description requirement of the Patent Act promotes the progress of the useful arts by ensuring that patentees adequately describe their inventions in their patent specifications in exchange for the right to exclude others from practicing the invention for the duration of the patent's term. Indeed, the specification does not satisfy the written description requirement because the specification does not describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the record" in line 13 and the limitation "the table" in line 14 of the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 4 recites the limitation "the name" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the database manager software program" in line 10 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 1, 5, 6, 8 and 9, language "*may be*" (line 14 of claim 1; line 8, line 9 and line 11 of claim 5; line 12 and line 13 of claim 6; line 9 and line 10 of claim 8; line 7 and line 8 of claim 9) raises question whether the claim will perform the acts. It is suggested to change "may be" to "is".

Any claim, which is not addressed, is rejected as incorporating the deficiencies of dependent claim 1 upon which they depend.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1-9, the “computer-readable medium” is not limited to tangible media in accordance with Applicant’s specification (see [page 27]), which states that it includes transmission media such as an acoustic or light wave, not in and of itself a tangible medium.

Regarding claim 10, the subject matter “controller” not supported by the specification is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Millet et al. (Publication No US 2003/0154197).

As to claim 1, Millet et al. teach:

“A computer-readable medium having stored thereon a computer-readable program code comprising a sequence of instructions which, when executed by a computer, cause the computer to perform steps” (see Abstract and [0040]) comprising:

“forming a first user-defined data field structure, or first “UDF” (see Abstract, [0040], [0048] and Fig. 13 each of the records in the “Custom Field Values” data table is equivalent to Applicant’s “UDF”), the first UDF comprising:

“an record identifier datafield” (see [0042], [0044], [0048], [0054] and Fig. 13 for “Row ID” datafield);

“an UDF identifier datafield” (see [0048] and Fig. 13 for “Field ID” datafield);

“a first datafield” (see [0048], Fig. 13 and Fig. 15 wherein “Value” or FieldValue” datafield is equivalent to Applicant’s “first datafield”);

“storing a record identifier in the record identifier datafield” (see Fig. 13);

“storing a UDF identifier in the UDF identifier datafield” (see Fig. 13); and

“storing an additional information in the first datafield, whereby the first datafield is associated with the record and the additional information stored in the first datafield may be associated with the record and without modification of the table” (see Abstract, [0048] and Fig. 13).

As to claim 2, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“forming a metadata, the metadata comprising a classification of data type, the classification of data type distinguishing the data type of the additional information stored in the first datafield; and associating the metadata with the first UDF” (see [0048], [0056] and Fig. 10 wherein attribute information is equivalent to Applicant’s “metadata”, the type of data in the field is equivalent to Applicant’s “classification of data type”; also see [0041] and [0073]).

As to claim 3, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“forming a metadata, the metadata associated with the first UDF, and the metadata comprising a name, the name associated with the first UDF and the name for use in software operations accessing the first UDF; and associated the metadata with the first UDF” (see Abstract, [0048], [0056] and Fig. 10 wherein field attribute information store in “Custom Fields” table is equivalent to Applicant’s “metadata associated with the first UDF”, and field name such as “Memo” is associated with a custom field or UDF as illustrated in Applicant’s claim language; also see [0073]).

As to claim 4, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“forming a metadata, the metadata comprising a title, the title associated with the first UDF and the name for use in a visual display of the additional information of the first UDF; and associating the metadata with the first UDF (see [0056] wherein field attribute information in “Custom Fields” table is equivalent to Applicant’s “metadata associated with the first UDF”, and “text associated with that field” is equivalent to title as illustrated in Applicant’s claim language).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“forming a class plurality of UDF’s and wherein the first datafield comprises a class identifier of the class plurality of UDF’s” (see [0048], Fig. 12 and Fig.15 wherein set of custom fields associated with each database table within the RDBMS is equivalent to Applicant’s “a class plurality of UDF’s”, and “TableID” or “ValueID” is equivalent to Applicant’s “class identifier”) , and each UDF of the class plurality includes:

“the class identifier” (see Fig. 10-12 wherein “TableID” is equivalent to Applicant’s claim language);

“a unique identifier of the UDF of the class plurality of UDF’s” (see Fig. 10 wherein “FieldID” is equivalent to Applicant’s claim language).

“a datafield, whereby each datafield of the class plurality of UDF’s may be associated with the first UDF and therefrom associated with the record, and information may be stored in the plurality of datafields of the class plurality of UDF’s and associated with the first UDF’s, and therefrom the information of the plurality of datafields of the class plurality of UDF’s may be

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associated with the record and without modification of the table (see Fig. 10, and Fig 13 wherein records of table in Fig. 10 is equivalent to Applicant's "the class plurality of UDF's", each record of table in Fig. 13 is equivalent to Applicant's "first UDF", the "FieldID" in both table indicates the association between two table or the association between the class plurality of UDF's and the first UDF as in Applicant's claim language, the "RowID" in table of Fig. 13 indicates the associate between that table and the database table, or, in other words, the association between UDF and class plurality of UDF's with records in the database table as illustrated in Applicant's claim language; also see [0057]).

As to claim 6, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

"forming a plurality of UDF's" (see Fig. 15 and [0057] wherein "Custom Field Values" table is equivalent to Applicant's "data structure" and its records is equivalent to Applicant's "a plurality of UDF's");

"storing an identifier of the first UDF in the record identifier datafield of each of the plurality of UDF" (see Fig. 15 wherein "FieldID" is equivalent to Applicant's claim language);

"storing a unique identifier in the record identifier datafield of each of the plurality of UDF's" (see Fig. 5 wherein "ValueID" is equivalent to Applicant's claim language); and

"storing information in each of the first datafields of each of the plurality of UDF's, whereby the plurality of first datafields of each of the plurality of UDF's are associated with the first UDF and information may be stored in the plurality of datafields and associated with the

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first UDF and therefrom the information of the plurality of datafields may be associated with the record and without modification of the table” (see Fig. 5 and [0057]-[0058] wherein “RecordID” is equivalent to “datafield” as illustrated in Applicant’s claim language since “RecordID” is a primary/foreign key which allows connecting record to another record which includes plurality of datafields; also see [0046]).

As to claim 7, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“to store a pointer in the record identifier datafield for use as the record identifier” (see Fig. 13, [0048] and [0054] wherein “RowID” is equivalent to Applicant’s “a pointer” and “the record identifier” because it points to location of the record in the table).

As to claim 8, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“forming a plurality of UDF’s, each UDF associated with a same record stored in a table” (Fig. 15 and [0057] wherein “Custom Field Values” table is equivalent to Applicant’s “data structure” and its records is equivalent to Applicant’s “a plurality of UDF’s”),

“whereby the plurality of first datafields are associated with the same record and information may be stored in the plurality of datafields and associated with the first UDF and therefrom the information of the plurality of datafields may be associated with the same record

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and without modification of the table” (see Fig. 5 and [0057]-[0058] wherein “ValueID” is equivalent to “datafield” as illustrated in Applicant’s claim language since “ValueID” is a primary/foreign key which allows connecting record to another record which includes plurality of datafields; also see [0046]).

As to claim 9, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Millet et al. teach:

“forming a data structure having a record, a list and a list user-defined field, or List “UDF”, the List UDF relatable to the record” (see [0041], [0048] and Fig. 15 wherein a table is a list of records, and any custom field associated with the table is equivalent to Applicant’s “list user-defined field”), and the List UDF comprising:

“an identifier of the List UDF” (see Fig. 10 wherein “FieldID” is equivalent to Applicant’s claim language);

“an identifier of the List” (see Fig. 10 wherein “TableID” is equivalent to Applicant’s “claim language”); and

“a data address of the List, whereby an information stored at the data address of the List is associated with the List UDF and the information may be stored or modified at the data address of the list and the information may be associated with the record and without modification of the table” (see [0073] and [0074] wherein the second values table as disclosed is equivalent to the List and the disclosure of retrieval of information from the table implies the inclusion of some data address to access table from its storage).

As to claim 10, Millet et al. teach:

“A computer system” (see Abstract) comprising:

“a controller” (see [0040]);

“a memory, the memory communicatively coupled with the controller and the memory storing a software database and a software database manager” (see [0040] for database and database application);

“a software database having data organized into a table of records” (see [0041]);

“a user-defined field stored in the memory for associating a datum with a record of the table, the user defined field having a UDF identifier and a record identifier” (see [0040], [0048], [0073] and Fig. 13 and 15 wherein “FieldID” is equivalent to Applicant’s “UDF identifier”, and “RowID” or “RecordID” is equivalent to Applicant’s “record identifier”);

“a metadata stored in the memory and associated with the user-defined field and the metadata specifying the data type of the datum” (see [0056] and Fig. 10 wherein field attribute information is equivalent to metadata as illustrated in Applicant’s claim language); and

“the database manager software program for directing the controller to merge the user-defined field with the record to associate the datum of the user-defined field with the record of the table” (see [0040] and [0061] wherein the application allowing user to add data column as necessary as disclosed is equivalent to Applicant’s “database manager software program”).

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571) 272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuong - Thao Cao

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PTC

March 12, 2007

C. Rones
CHARLES RONES
SUPERVISORY PATENT EXAMINER

JM
JEAN M. CORRIELUS
PRIMARY EXAMINER
Art unit 2162

In the Specification

[0102] The term "computer-readable medium" as used herein refers to any medium that participates in providing instructions to the network 2 for execution. Such a medium may take many forms, including but not limited to, non-volatile media, volatile media, and transmission media. Non-volatile media includes, for example, optical or magnetic disks, such as storage device 10. Volatile media includes dynamic memory. Transmission media includes coaxial cables, copper wire and fiber optics. ~~Transmission media can also take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications.~~

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